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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/024,923	02/17/1998	DAN KIKINIS	P3295	8936

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EXAMINER	
FERRIS, DERRICK W	
ART UNIT	**PAPER NUMBER**
2616	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/024,923	KIKINIS, DAN	
	Examiner	Art Unit	
	Derrick W. Ferris	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 December 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *29-31,33-38,40-45,47-52 and 54-57* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *29-31, 33-38, 40-45, 47-52, 54-57* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. This Office action is in response to applicant's paper filed 12/14/2006. **Claims 29-31, 33-38, 40-45, 47-52, 54-57** are pending.

2. The examiner **withdraws** the anticipated rejection to *Iwami* based on applicant's claim amendment(s). As such, please find a new rejection as necessitated by amendment. With respect to the rejection, *Iwami* teaches a digitally-stored look-up table in FIG. 18 which is found on server 20. The lookup-table further contains COST telephone numbers as extension numbers 311 and DNT addresses as Communication Terminal Addresses 312. *Iwami* may not clearly teach that the Communication Terminal Addresses 312 are IP addresses for accessing the Internet. In particular, the Communication Terminal Addresses appear to be in IP format and *Iwami* further supports TCP/IP and UDP/IP, see e.g., column 17, lines 45-50. Thus the examiner proposes to modify the *Iwami* reference to include IP as the LAN addresses 311 by including the obviousness rejection in view of *Chang*. In addition, the examiner notes that *Chang* further supports a lookup-table that includes telephone number and IP addresses, see e.g., column 4, lines 10-25 with respect to a translation table. The examiner further notes that the references in combination teach that it would have been obvious to locate the translation server at the bridge unit or server 20 as taught by *Iwami* (i.e., *Iwami* clearly teaches that the translation table is found at the gateway or server 20). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

3. The examiner does not **withdraw** the obviousness rejection to *Iwami* in view of *Mitel*. The examiner notes similar reasoning applies as mentioned above in the obviousness rejection to *Iwami* in view of *Chang*.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. **Claims 29-31, 33-38, 39, 40-45, 47-52, and 54-57** is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,604,737 A to *Iwami et al. et al.* ("*Iwami*") in view of U.S. Patent No. 6,198,738 B1 to *Chang et al.* ("*Chang*").

As to **claim 29**, *Iwami* discloses a bridge unit and a method comprising a trunk line port for receiving and placing COST telephone calls (i.e., fig. 1, between 20 and 3, inherently there's a port in order to connect the PSTN network to the server 20) ; a data network port and circuitry for placing LAN calls (i.e., fig. 1 between 20 and 1, inherently there's a port in order to connect the server to the LAN); conversion between LAN and COST telephone calls (i.e., fig 7, 22, fig. 8, col. 11, II. 5-15); a digitally-stored lookup table (i.e., column 17, ll. 3-7) relating COST telephone numbers to LAN addresses (i.e., column 15, ll. 41-54, the terminal may have a telephone number so the communication may be established and connection to take place) wherein control routine function, extract specific data to access the lookup table (i.e., fig. 18, col. 15, ll. 41-55, the extension and/or the terminal address has to be extracted in order to be compared) and

enabling two people to engage in a live conversation and protocol conversion (i.e., fig. 8, col. 11, ll. 20 – column 12, ll. 15). See processor 17 in figure 6 with respect to a processor for the bridge.

Iwami may be silent or deficient to teaching IP addresses and the Internet. In particular, *Iwami* teaches a digitally stored table as shown in FIG. 18 that relates COST telephone numbers as Extension Numbers 311 and IP addresses as Communication Terminal Addresses 312. In particular, the table shows Communication Terminal Addresses as LAN Addresses for LAN network 1 shown e.g., in FIG. 1. *Iwami* further teaches that LAN network 1 may support TCP/IP protocol, see e.g., column 17, lines 45-55. The examiner furthermore notes that the LAN addresses appear to be in IP address format in FIG. 18. However, the *Iwami* reference does not explicitly teach the Internet.

Chang teaches the further recited limitation above with respect to FIG. 1 where the Internet is shown as network 20. See also column 1, lines 13-42. *Chang* also teaches a database that contains COST telephone numbers and IP addresses, see e.g., column 4, lines 6-25 since the ULS server contains a database of address translations.

The proposed modification of the above-applied reference(s) necessary to arrive at the claimed subject matter would be to modify *Iwami* by clarifying it is well known in the art to transmit TCP/IP traffic over the Internet.

As such, examiner notes that it would have been obvious to one skilled in the art prior to applicant's invention to include the above limitation. In particular, the motivation for modifying the reference would be to communicate over widespread networks that

further include packetized data. *Chang* further teaches the above motivation at e.g., column 1, lines 26-41.

As to **claim 30**, the public network 3 is the PSTN as taught by *Iwami*, see e.g., column 7, lines 1-6.

As such to **claim 31**, see similar rejection for the parent claim(s).

As to **claim 33**, see e.g., figure 18 of *Iwami* where the IP address corresponds to the telephone number.

As to **claims 34**, see e.g., figure 5 of *Iwami* which shows a flow chart of call negotiation from the PSTN to a packet-based network.

As to **claims 35**, see also figure 5 of *Iwami* with respect to the voice mail option.

As to **claim 36**, see similar rejection to claim 29.

As to **claim 37**, see similar rejection to claim 30.

As to **claim 38**, see similar rejection to claim 31.

As to **claim 40**, see similar rejection to claim 33.

As to **claim 41**, see similar rejection to claim 34.

As to **claim 42**, see similar rejection to claim 35.

As to **claim 43**, see similar rejection to claim 29.

As to **claim 44**, see similar rejection to claim 30.

As to **claim 45**, see similar rejection to claim 31.

As to **claim 46**, see similar rejection to claim 32.

As to **claim 47**, see similar rejection to claim 33.

As to **claim 48**, see similar rejection to claim 34.

As to **claim 49**, see similar rejection to claim 35.

As to **claim 50**, see similar rejection to claim 29.

As to **claim 51**, see similar rejection to claim 30.

As to **claim 52**, see similar rejection to claim 31.

As to **claim 54**, see similar rejection to claim 33.

As to **claim 55**, see similar rejection to claim 34.

As to **claim 56**, see similar rejection to claim 35.

As to **claim 57**, see similar rejection to claim 29.

6. **Claims 29, 36, 43, 50 and 57** is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,604,737 A to *Iwami et al. et al.* ("*Iwami*") in view of GB 2 315 190 A to *Mitel.*

As such to **claim 29**, *Iwami* discloses a bridge unit and a method comprising a trunk line port for receiving and placing COST telephone calls (i.e., fig. 1, between 20 and 3, inherently there's a port in order to connect the PSTN network to the server 20) ; a data network port and circuitry for placing LAN calls (i.e., fig. 1 between 20 and 1, inherently there's a port in order to connect the server to the LAN); conversion between LAN and COST telephone calls (i.e., fig 7, 22, fig. 8, col. 11, II. 5-15); a digitally-stored lookup table (i.e., column 17, ll. 3-7) relating COST telephone numbers to LAN addresses (i.e., column 15, ll. 41-54, the terminal may have a telephone number so the communication may be established and connection to take place) wherein control routine function, extract specific data to access the lookup table (i.e., fig. 18, col. 15, ll. 41-55, the extension and/or the terminal address has to be extracted in order to be compared) and

enabling two people to engage in a live conversation and protocol conversion (i.e., fig. 8, col. 11, ll. 20 – column 12, ll. 15). See processor 17 in figure 6 with respect to a processor for the bridge.

Iwami may be silent or deficient to teaching IP addresses and the Internet. In particular, *Iwami* teaches a digitally stored table as shown in FIG. 18 that relates COST telephone numbers as Extension Numbers 311 and IP addresses as Communication Terminal Addresses 312. In particular, the table shows Communication Terminal Addresses as LAN Addresses for LAN network 1 shown e.g., in FIG. 1. *Iwami* further teaches that LAN network 1 may support TCP/IP protocol, see e.g., column 17, lines 45-55. The examiner furthermore notes that the LAN addresses appear to be in IP address format in FIG. 18. However, the *Iwami* reference does not explicitly teach the Internet.

Mitel teaches the further recited limitation above at e.g., page 9 first full paragraph since the gateway provides a one-to-one mapping function between the user's telephone number and TCP/IP address. Thus *Mitel* teaches that it is well known in the art to use an IP address.

The proposed modification of the above-applied reference(s) necessary to arrive at the claimed subject matter would be to modify *Iwami* by clarifying that a translation table can also contain IP addresses.

As such, examiner notes that it would have been obvious to one skilled in the art prior to applicant's invention to include the above limitation. In particular, the motivation for modifying the reference or to combine the reference teachings would be in order to

communicate with the greatest number of possible users. The motivation is also the desire to use the network that is most broadly available and therefore preferred.

As to **claim 36**, see similar rejection to claim 29.

As to **claim 43**, see similar rejection to claim 29.

As to **claim 50**, see similar rejection to claim 29.

As to **claim 57**, see similar rejection to claim 29.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick W. Ferris whose telephone number is (571) 272-3123. The examiner can normally be reached on M-F 9 A.M. - 4:30 P.M. E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on (571)272-3134. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Derrick W. Ferris
Examiner
Art Unit 2616

DWF

DERRICK W. FERRIS
PRIMARY PATENT EXAMINER